

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION**

IMPINJ, INC.,

Plaintiff,

v.

**NXP USA, INC., NXP
SEMICONDUCTORS NETHERLANDS
B.V.,**

Defendants.

§
§
§
§
§
§
§
§
§
§

CIVIL NO. W-21-CV-00530-ADA

**ORDER ADOPTING MAGISTRATE
JUDGE'S REPORT AND RECOMMENDATION**

Before the Court is the Report and Recommendation of United States Magistrate Judge Derek T. Gilliland. ECF No. 288. The Report and Recommendation was issued on October 12, 2023. ECF No. 288. The Report recommends the following as memorialized in the below tables:

Dkt. No.	Motion	The Court's Order
170	NXP's Motion for Partial Summary Judgment	<p>GRANTED IN PART AND DENIED IN PART.</p> <p>Motion No. 1 is GRANTED with regard to NXP Japan's, NXP Shanghai's, and Defendants NXP Netherland B.V.'s international sales.</p> <p>Motion No. 2 seeking summary judgment that the asserted claims of '835 and '227 patents are necessary to practice the Gen2 standard is DENIED.</p> <p>Motion 4B, seeking summary judgment of no infringement of the '251 patent or the '835 patent because the accused products do not contain a "transponder" or "RFID Tag" is DENIED.</p> <p>Motion 4C seeking summary judgment of no infringement of claims 1, 52 and 61 of the</p>

Dkt. No.	Motion	The Court's Order
		<p>'835 patent because the accused products do not contain a "processor" is DENIED.</p> <p>All other aspects of the motion are tabled for a future trial.</p>
171	Impinj's Motion for Partial Summary Judgment of Non-Infringement and no Pre-Suit Damages	DENIED.
173	Impinj's Motion to Exclude Certain Opinions of David Haas	DENIED.
175	Impinj's Motion to Strike	<p>Sections B1, B4, C and E are DENIED.</p> <p>Section C is DENIED, but NXP cannot argue that checking whether a power adequacy condition is met excludes checking of voltage.</p> <p>All other sections of the motion are tabled to be fully addressed at a future trial.</p>
177	Impinj's Motion to Exclude Certain Testimony	DENIED.
178	NXP's Motion to Exclude Certain Testimony	<p>Motion No. 1 DENIED.</p> <p>Motion No. 2 DENIED based on granting of Motion No. 1 of Dkt. 170. To the extent that Order is reversed, Motion No. 2 will be revisited.</p> <p>Motion No. 3 GRANTED IN PART AND DENIED IN PART.</p> <p>Section C.3 of Motion No. 3 seeking exclusion of infringement theories for the UCODE 7xm/7xm+ products is GRANTED. All other sections of Motion No. 3 related to the '251, '835, and '227 patents are DENIED.</p> <p>All other sections of Motion No. 3 related to patents other than the '251, '835, and '227 patents are tabled to be fully addressed at a future trial.</p>
179	Impinj's Motion for Partial Summary Judgment (Affirmative Case)	<p>DENIED.</p> <p>The Court holds that the preamble of claim 8 for the '251 patent, the "RFID transponder" is not limiting.</p>

Dkt. No.	Motion	The Court's Order
		<p>The Court holds a processor is not limited to a component that executes software or is otherwise configurable.</p> <p>Impinj's motion for summary judgment of infringement of the '251 patent is DENIED.</p> <p>Impinj's motion for summary judgment of infringement of the '835 patent is DENIED.</p> <p>Impinj's motion for summary judgment that the '251, '227, and '835 patents are not necessary to practice the Gen2 protocol is DENIED.</p> <p>Impinj's motion seeking to dismiss NXP's defenses and counterclaims related the Gen 2 necessary practice defenses is DENIED.</p> <p>All other aspects of the motion are tabled for consideration at a future trial.</p>
214	Impinj's Motion to Amend Infringement Contentions re '251 and '835 Patents	<p>The motion on the '251 patent is DENIED.</p> <p>The motion relating to the '835 patent is GRANTED insofar as Impinj may assert indirect infringement of claim 41, but Impinj shall not be required to formally amend its infringement contentions.</p>

MOTIONS IN LIMINE

Dkt. No.	Motion	The Court's Order
249	NXP's Motions <i>in Limine</i>	<p>GRANTED IN PART AND DENIED IN PART.</p> <p>Motion No. 2 is GRANTED for lack of opposition.</p> <p>Motions 1, 3 and 4 are DENIED, but objections may be raised at trial.</p>
250	Impinj's Motions <i>in Limine</i>	Motions Nos. 2 through 4 are denied but objections may be raised at trial.

		Motion No. 1 was AGREED by the parties and Motion No. 5 was WITHDRAWN by Impinj.
262	Impinj's Motion Strike or, in the Alternative, for Leave to File Sur-Reply	GRANTED IN PART AND DENIED IN PART. Motion to Strike is DENIED Motions for Leave to File Sur-Reply is GRANTED, and the clerk is instructed to file 262-1, Exhibit 1, Impinj's Sur-reply on the docket.

A party may file specific, written objections to the proposed findings and recommendations of the magistrate judge within fourteen days after being served with a copy of the report and recommendation, thereby securing *de novo* review by the district court. 28 U.S.C. § 636(b); Fed. R. Civ. P. 72(b). A district court need not consider “[f]rivolous, conclusive, or general objections.” *Battle v. U.S. Parole Comm’n*, 834 F.2d 419, 421 (5th Cir. 1987) (quoting *Nettles v. Wainwright*, 677 F.2d 404, 410 n.8 (5th Cir. 1982) (en banc), *overruled on other grounds by Douglass v. United States Auto. Ass’n*, 79 F.3d 1415 (5th Cir. 1996)).

Defendant filed objections on October 26, 2023. ECF No. 294. Plaintiff filed objections on October 26, 2023. ECF No. 296. Defendant filed a response to Plaintiff’s objections on October 26, 2023. ECF No. 297. The Court has conducted a *de novo* review of the motions, the responses, the report and recommendation, the objections and responses to the report and recommendation, and the applicable laws. After that thorough review, the Court is persuaded that the Magistrate Judge’s findings and recommendation should be adopted.

IT IS THEREFORE ORDERED that the Report and Recommendation of United States Magistrate Judge Gilliland, ECF No. 288, is **ADOPTED**.

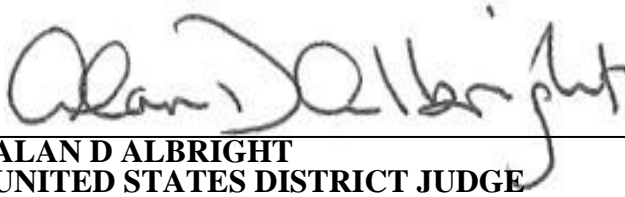
IT IS FURTHER ORDERED that Defendant’s objections are **OVERRULED**.

IT IS FURTHER ORDERED that Plaintiff's objections are **OVERRULED**.

IT IS FURTHER ORDERED that Plaintiff's Motions are **GRANTED IN PART AND DENIED IN PART** in accordance with the Report and Recommendation as memorialized in the above tables.

IT IS FINALLY ORDERED that Defendant's Motions are **GRANTED IN PART AND DENIED IN PART** in accordance with the Report and Recommendation as memorialized in the above tables.

SIGNED this 27th day of October, 2023.



ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE